

Docket No.: 146392005000
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorothea REILLY et al.

Application No.: 10/697,995

Confirmation No.: 7395

Filed: October 30, 2003

Art Unit: 1644

For: METHODS AND COMPOSITIONS FOR
INCREASING ANTIBODY PRODUCTION

Examiner: I. Ouspenski

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

On behalf of applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is being filed with payment of the issue fee and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request a credit of 402 days be added to the 328 days of adjustment as indicated on the Notice of Allowance. The additional credit, minus applicants' delay, results in a revised total of 730 days of patent term adjustment.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Notice of Allowance, mailed January 28, 2009, applicants are entitled to 328 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 328 days and reconsideration is respectfully requested.

The Office failed to mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 within 14 months of the filing date of the present application. The Office correctly credits applicants 447 days of adjustment in accordance with 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1), 1.703(a)(1).

Applicants filed a response on October 27, 2006 to a non-final office action, mailed June 30, 2006. The Office correctly calculates 27 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on June 8, 2007 to a non-final office action, mailed January 8, 2007. The Office correctly calculates 61 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on June 26, 2008 to a non-final office action, mailed February 26, 2008. The Office correctly calculates 31 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

The Office has failed to issue a patent within 3 years after the date on which the present application was filed (October 30, 2003). Based on a projected issue date of August 11, 2009, applicants are entitled to an additional credit of 402 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

Under the USPTO's Exclusion Interpretation of 35 USC 154(b)(2)(A) and application of 37 CFR 1.703(f) Actual Delay Limitation, the Office would conclude that the 402 days of

adjustment for failure to issue a patent within 3 years constitute “overlap” with the 447 days of adjustment for failure to issue an action within 14 months and thus, would not include the 402 days in the total calculation of term adjustment.

In light of Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), applicants assert that the Actual Delay Limitation under 37 CFR 1.703(f) is no longer applicable and thus, the 402 days of delay under the 3-Year PTO Issue of Patent rule should be added to the 447 days of delay under the 14-Month PTO First Action rule.

Applicants calculate a total PTO delay of 849 days and applicants’ delay of 119 days, for a revised total of 730 days of additional patent term. Based on the foregoing information, applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 146392005000.

Dated: April 28, 2009

Respectfully submitted,

Electronic signature: /Gregory P. Einhorn/
Gregory P. Einhorn

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